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| 09/807,093 | 05/24/2001 | Eddy Daelmans | 501139 | 2724 |

23626 7590 12/23/2003
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| EXAMINER |
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DICUS, TAMRA

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| ART UNIT | PAPER NUMBER |
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1774

DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/807,093

Applicant(s)

DAELMANS ET AL

Examiner

Tamra L. Dicus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7 and 10 is/are rejected.
- 7) ☒ Claim(s) 5,6,8,9 and 11-19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

The 112 rejections are withdrawn. The 102(e) and 103(a) rejections are withdrawn.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 7 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 3,055,576 to Ottinger et al.

Ottinger teaches a wrapping material that is wound, comprising a web, where a water proof stripe (strip) of self-sealing latex adhesive on two outer edges of the web (inner and outer strips), which does not adhere to a surface when pressed against another surface such as in the wound roll. Such explanation is a functional equivalent to Applicant's new limitation to the mutual contact relationship between the inner and outer strips in a wound state on the roll. See col. 1, lines 20-31, col. 2, lines 1-35, col. 3, lines 5-28, and Figures 1-5. Ottinger explains at col. 3, line 26 that such a wrapping may be suitable for other materials besides carpet to wrap elongated objects. Ottinger shows a traverse edge in Figure 1 and at col. 2, lines 24-25 and 60-65. In regards to the strength of the adhesive e.g. "strong enough...but not strong enough...", Ottinger explains the adhesive is pressed against the margins of the web adhered to one another, but not to a surface which doesn't have the adhesive at col. 2, lines 5-17, which avoids the roll sticking together. Since the adhesive is in a roll and it doesn't stick to the roll, this explanation is functionally equivalent to the description of the strength of the adhesive as Applicant claims.

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The process limitations “adapted to be cut/closed” and “...is spread out in the form of an egg-shaped strip” are not dispositive of the issue of patentability of the present article claims. The phrase “adapted to be cut/closed” is indefinite, as the phrase does not state how it is adapted, or what this involves. Further the phrase is a process limitation, which is not considered in a product claim.

Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531.

Allowable Subject Matter

Claims 5-6, 8-9, and 11-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 10-14-03 have been fully considered but they are not persuasive.

Applicant alleges an interview was not arranged and that the Examiner would not yield any further Office Actions until an interview was conducted pursuant to Applicant's Interview Request Form and this Amendment. The Examiner promised no such thing. The interview was granted to the Applicant on 11-05-03. The Applicant looks forward to receiving an interview,

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however, Applicant very well acknowledges this interview, as he sent an interview summary record on 11-05-03. The issues were already clarified and discussed in the interview.

Applicant alleges “adapted to be cut” and/or “adapted to be closed” is not indefinite as he believes support is found in case law. During the interview it was said that we would withdraw the rejections over claim 10. Therefore, this argument is moot.

Applicant alleges he does not understand paragraph 10 of the previous Office Action. During in the interview, the Office advised the applicant to resend the EP translation document as we have not received it. The Examiner states again to re-submit the EP translation document.

Applicant alleges that Ottinger does not teach mutual contact between strips on opposing sides of the film existing in a wound state on a roll. This is not true. Ottinger very well teaches the web in a roll, having the cold-seal strips. See col. 1, lines 20-31, col. 2, lines 1-35, col. 3, lines 5-28, and Figures 1-5. Col. 2, lines 11-17 explicitly state stripes 7 and 9 are adhered to one another in a roll R. This teaching is equivalent to Applicant’s language, e.g. “mutual contact exists between inner and outer strips in the wound state on the roll”. Figure 4 shows strips 7 and 9 on opposing sides of the film to Applicant’s disbelief. The Applicant has not made a persuasive argument. Therefore the 102(b) rejection is proper.

Applicant alleges that Jones does not teach the strips wound in a roll since a leafing material is present. During the interview, the Examiner agreed to withdraw the Jones rejection, and the rejection is hereby withdrawn.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is (703) 305-3809. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-8329 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Tamra L. Dicus
Examiner
Art Unit 1774

December 21, 2003


ELIZABETH MULVANEY
PRIMARY EXAMINER